

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of	:	Docket No. 0404-04501US
MICHAEL REGAN	:	Confirmation No. 7533
U.S. Application No. 10/824,668	:	
Filing Date: April 14, 2004	:	
For: INSULATED RF SUPPRESSOR FOR	:	
INDUSTRIAL MAGNETRONS	:	

REQUEST FOR RECONSIDERATION

In response to the Advisory Action mailed on June 5, 2007, the Applicant requests reconsideration of the Examiner's decision not to withdraw the application from final rejection status. The Applicant believes that the Examiner's refusal to withdraw the application from final is an abuse of discretion for the following reasons.

The Examiner's decision to make the Action mailed on February 20, 2007 final is unfair to the Applicant. The Examiner failed to clearly explain the basis of the rejection of Claim 1 in either of the non-final actions of February 24, 2006 and September 12, 2006. For example, in the action mailed on February 24, 2006 the Examiner stated only the following: "Claims 1-3, 6-8 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the admitted prior art shown in figures 1-6 and pages 1-10 of the specification." That statement is so vague that the Applicant could not properly respond to it. In the response filed on May 24, 2006, the Applicant pointed out the imprecision of the rejection and requested that the Examiner indicate more specifically what drawing figure and what text he was referring to so that the Applicant could consider the alleged disclosure and respond accordingly.

In the non-final action mailed on September 12, 2006, the Examiner withdrew the

rejections of Claims 3-20, but maintained the rejection as to Claims 1 and 2. In making the rejection the Examiner stated "Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the admitted prior art shown in figures 1-6 and pages 1-10 of the specification." In response to the Applicant's arguments that the specification does not describe a two-piece radiation suppressor for a magnetron the Examiner stated "Applicant's argument that figure's [sic] 1-6 do not show at least a two part magnetron [sic] as is well known in the art please read pages 1-10 of the specification regarding the construction of a typical magnetron using ceramics and metallic construction." Besides being unclear, the quoted text is not even a complete sentence.

On November 1, 2006, the Applicant's attorney contacted the Examiner by telephone in an attempt to obtain a clarification of the basis for the rejection and a more specific indication of what portions of the specification the Examiner was relying on as describing a two-piece radiation suppressor as set forth in the rejected claims. The Examiner could not specify the particular text or drawings he had relied on and invited the Applicant's attorney to file a response pointing out the differences between the claimed radiation suppressor and the known suppressor as described in the Background section of the specification.

In the response submitted on November 24, 2006, the Applicant again tried to point out the differences between the claimed radiation suppressor and the known suppressor described in the Background section of the specification. Reference was made to the telephone interview of November 1, 2006.

In the Official Action mailed on February 20, 2007, the Examiner maintained the rejection of Claims 1 and 2 under Section 102(b), but did provide an additional comment regarding the basis for the rejection. However, the Examiner made the action final, thereby

cutting off Applicant's ability to amend the claims to distinguish the claimed invention from the cited devices. If the Examiner had provided a proper explanation of the basis for the rejection under Section 102 in either of the non-final actions on the merits, then the Applicant could have submitted an appropriate amendment earlier in the prosecution process.

MPEP §706 states in pertinent part:

After the application has been read and the claimed invention understood, a prior art search for the claimed invention is made. With the results of the prior art search, including any references provided by the applicant, the patent application should be reviewed and analyzed in conjunction with the state of the prior art to determine whether the claims define a useful, novel, nonobvious, and enabled invention that has been clearly described in the specification. *The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.* (Emphasis added.)

Before a final action is proper, there should be a clear issue developed between the Examiner and Applicant. MPEP §706.07 The failure of the Examiner to provide a clear basis for the rejection in the non-final actions and failing to set forth a clear basis for the rejection until the final rejection defeats the goal of reaching a clearly defined issue for either an allowance of the application or a final rejection. Further, such failure has inhibited the Applicant from being able to properly address the rejection by submitting appropriate amendments and/or arguments. An applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. *Id.*

In the present case, the Applicant has diligently sought clarification of the basis for the rejection under Section 102 so that he could provide an appropriate response. The Applicant has also diligently sought to point out the patentable differences in his claimed invention relative to

the known devices as understood by him and described in his own specification, the primary reference cited against the claims of this application. The clarification of the basis for the lack of novelty rejection was not forthcoming until the final rejection. Cutting off the Applicant's ability to amend the claims under the circumstances of this case is manifestly unfair.

CONCLUSION

For all of the foregoing reasons, it is respectfully requested that the finality of the action mailed on February 20, 2007 be withdrawn and that the amendment to Claim 1 be entered and considered.

Respectfully submitted,

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